

## Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	85887934
LAW OFFICE ASSIGNED	LAW OFFICE 108
MARK SECTION (no change)	
ARGUMENT(S)	
<p>In the Examining Attorney's February 7, 2014 final Office Action, she maintained her refusal to register Applicant's instant mark on the grounds that registration of Applicant's mark would lead to a likelihood of confusion with the mark TURIN &amp; Design (Reg. No. 2763180) under Trademark Act Section 2(d) and that Applicant's mark was either primarily geographically descriptive under Trademark Act Section 2(e)(2) or primarily geographically deceptively misdescriptive under Trademark Act Section 2(e)(3).</p> <p>With respect to the refusal based upon Section 2(d) of the Trademark Act, Applicant notes that Registrant's mark registered with a distinctiveness limitation as to the term TURIN. Thus, it would appear that Registrant's mark, which the Examining Attorney notes is the foreign equivalent to Applicant's mark, was allowed to register on the Principal Register without facing any deceptiveness refusal notwithstanding the fact that the Registrant was not located in Turin and there is no indication in the file history for Reg. No. 2763180 that the goods or the ingredients for the goods originate in Turin. Accordingly, due to the fact that Turin and Torino are being viewed to be confusingly similar by the Examining Attorney under the doctrine of foreign equivalents, it would be against public policy and the consistent handling and treatment of marks by the USPTO if Applicant's mark for TORINO, which the Examiner holds to be a geographic term, was not allowed to register and coexist with Registrant's mark for a similar geographic term. This would be akin to affording one party the exclusive right to register marks containing the term NEW YORK or PARIS to the exclusion of other third parties.</p> <p>With respect to the refusal based upon Section 2(e)(2) of the Trademark Act, Applicant's mark is not primarily merely geographically descriptive as its goods do not originate in or contain ingredients from Turin.</p> <p>With respect to the refusal based upon Section 2(e)(3) of the Trademark Act, Applicant has been selling its products in the U.S. under the TORINO mark since 1950. Applicant's mark was in use for approximately 30 years prior to December 8, 1993 and therefore the mark acquired distinctiveness well prior to December 8, 1993. By virtue of Applicant's longstanding use of its mark, and pursuant to the relevant rules pre-NAFTA, Applicant seeks to amend the instant application to seek registration on the Principal Register under Section 2(f).</p>	
ADDITIONAL STATEMENTS SECTION	
TRANSLATION	The English translation of TORINO in the mark is TURIN.

<b>SECTION 2(f) Claim of Acquired Distinctiveness, based on Use</b>	The mark has become distinctive of the goods/services through the applicant's substantially exclusive and continuous use in commerce that the U.S. Congress may lawfully regulate for at least the five years immediately before the date of this statement.
<b>MISCELLANEOUS STATEMENT</b>	Applicant's goods do not originate in or contain ingredients from Turin; however, registration of Applicant's mark would not be deceptive for the reasons set forth in Applicant's response herein to the Examining Attorney's refusals based upon Section 2(d) and 2(e)(3) of the Trademark Act. Applicant is concurrently filing with this Request for Reconsideration a Notice of Appeal with the Trademark Trial and Appeal Board.
<b>SIGNATURE SECTION</b>	
<b>DECLARATION SIGNATURE</b>	/lwr/
<b>SIGNATORY'S NAME</b>	Lisa W. Rosaya
<b>SIGNATORY'S POSITION</b>	Attorney of record, New York bar member
<b>DATE SIGNED</b>	07/22/2014
<b>RESPONSE SIGNATURE</b>	/lwr/
<b>SIGNATORY'S NAME</b>	Lisa W. Rosaya
<b>SIGNATORY'S POSITION</b>	Attorney of record, New York bar member
<b>DATE SIGNED</b>	07/22/2014
<b>AUTHORIZED SIGNATORY</b>	YES
<b>CONCURRENT APPEAL NOTICE FILED</b>	NO
<b>FILING INFORMATION SECTION</b>	
<b>SUBMIT DATE</b>	Tue Jul 22 12:20:57 EDT 2014
<b>TEAS STAMP</b>	USPTO/RFR-208.193.53.242- 20140722122057074744-8588 7934-500f85567cb3aafa0683 1a6e832b8b26e8298c4465dc5 20c53ce6616cec46c7a41-N/A -N/A-20140722115254439379

## **Request for Reconsideration after Final Action To the Commissioner for Trademarks:**

Application serial no. **85887934** has been amended as follows:

### **ARGUMENT(S)**

**In response to the substantive refusal(s), please note the following:**

In the Examining Attorney's February 7, 2014 final Office Action, she maintained her refusal to register Applicant's instant mark on the grounds that registration of Applicant's mark would lead to a likelihood of confusion with the mark TURIN & Design (Reg. No. 2763180) under Trademark Act Section 2(d) and that Applicant's mark was either primarily geographically descriptive under Trademark Act Section 2(e)(2) or primarily geographically deceptively misdescriptive under Trademark Act Section 2(e)(3).

With respect to the refusal based upon Section 2(d) of the Trademark Act, Applicant notes that Registrant's mark registered with a distinctiveness limitation as to the term TURIN. Thus, it would appear that Registrant's mark, which the Examining Attorney notes is the foreign equivalent to Applicant's mark, was allowed to register on the Principal Register without facing any deceptiveness refusal notwithstanding the fact that the Registrant was not located in Turin and there is no indication in the file history for Reg. No. 2763180 that the goods or the ingredients for the goods originate in Turin. Accordingly, due to the fact that Turin and Torino are being viewed to be confusingly similar by the Examining Attorney under the doctrine of foreign equivalents, it would be against public policy and the consistent handling and treatment of marks by the USPTO if Applicant's mark for TORINO, which the Examiner holds to be a geographic term, was not allowed to register and coexist with Registrant's mark for a similar geographic term. This would be akin to affording one party the exclusive right to register marks containing the term NEW YORK or PARIS to the exclusion of other third parties.

With respect to the refusal based upon Section 2(e)(2) of the Trademark Act, Applicant's mark is not primarily merely geographically descriptive as its goods do not originate in or contain ingredients from Turin.

With respect to the refusal based upon Section 2(e)(3) of the Trademark Act, Applicant has been selling its products in the U.S. under the TORINO mark since 1950. Applicant's mark was in use for approximately 30 years prior to December 8, 1993 and therefore the mark acquired distinctiveness well prior to December 8, 1993. By virtue of Applicant's longstanding use of its mark, and pursuant to the relevant rules pre-NAFTA, Applicant seeks to amend the instant application to seek registration on the Principal Register under Section 2(f).

### **ADDITIONAL STATEMENTS**

#### **Translation**

The English translation of TORINO in the mark is TURIN.

#### **Section 2(f) Claim of Acquired Distinctiveness, based on Use**

The mark has become distinctive of the goods/services through the applicant's substantially exclusive and continuous use in commerce that the U.S. Congress may lawfully regulate for at least the five years immediately before the date of this statement.

**Miscellaneous Statement**

Applicant's goods do not originate in or contain ingredients from Turin; however, registration of Applicant's mark would not be deceptive for the reasons set forth in Applicant's response herein to the Examining Attorney's refusals based upon Section 2(d) and 2(e)(3) of the Trademark Act. Applicant is concurrently filing with this Request for Reconsideration a Notice of Appeal with the Trademark Trial and Appeal Board.

**SIGNATURE(S)****Declaration Signature**

DECLARATION: The signatory being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements and the like may jeopardize the validity of the application or submission or any registration resulting therefrom, declares that, if the applicant submitted the application or amendment to allege use (AAU) unsigned, all statements in the application or AAU and this submission based on the signatory's own knowledge are true, and all statements in the application or AAU and this submission made on information and belief are believed to be true.

STATEMENTS FOR UNSIGNED SECTION 1(a) APPLICATION/AAU: If the applicant filed an unsigned application under 15 U.S.C. Section 1051(a) or AAU under 15 U.S.C. Section 1051(c), the signatory additionally believes that: the applicant is the owner of the trademark/service mark sought to be registered; the applicant or the applicant's related company or licensee is using the mark in commerce and has been using the mark in commerce as of the filing date of the application or AAU on or in connection with the goods/services in the application or AAU, and such use by the applicant's related company or licensee inures to the benefit of the applicant; the original specimen(s), if applicable, shows the mark in use in commerce as of the filing date of the application or AAU on or in connection with the goods/services in the application or AAU; and to the best of the signatory's knowledge and belief, no other person has the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion or mistake, or to deceive.

STATEMENTS FOR UNSIGNED SECTION 1(b)/SECTION 44 APPLICATION: If the applicant filed an unsigned application under 15 U.S.C. Section 1051(b), Section 1126(d), and/or Section 1126(e), the signatory additionally believes that: the applicant is entitled to use the mark in commerce; the applicant has a bona fide intention and has had a bona fide intention as of the application filing date to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the goods/services in the application; and to the best of the signatory's knowledge and belief, no other person has the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion or mistake, or to deceive.

Signature: /lwr/ Date: 07/22/2014

Signatory's Name: Lisa W. Rosaya

Signatory's Position: Attorney of record, New York bar member

**Request for Reconsideration Signature**

Signature: /lwr/ Date: 07/22/2014

Signatory's Name: Lisa W. Rosaya

Signatory's Position: Attorney of record, New York bar member

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is not filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 85887934

Internet Transmission Date: Tue Jul 22 12:20:57 EDT 2014

TEAS Stamp: USPTO/RFR-208.193.53.242-201407221220570

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